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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/511,223	12/21/2004	Georg Gros	DNAG-293	2138
24972	7590	07/02/2007		
FULBRIGHT & JAWORSKI, LLP 666 FIFTH AVE NEW YORK, NY 10103-3198			EXAMINER VIJAYAKUMAR, KALLAMBELLA M	
			ART UNIT 1751	PAPER NUMBER
			MAIL DATE 07/02/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/511,223	Applicant(s) GROS, GEORG	
	Examiner Kallambella Vijayakumar	Art Unit 1751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 64-103 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 64-103 is/are rejected.
- 7) ☒ Claim(s) 81, 93 and 94 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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Detailed Action

- This application is a 371 of PCT/EP 03/04055 filed 04/17/2003. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.
- The second preliminary amendment filed 07/27/2005 has been entered.

Claims 64-103 are currently pending with the application.

- The examiner has considered the IDS filed 02/15/2007, 03/06/2006 and 08/01/2005.

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A (1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the examiner has cited by the references on form PTO-892 and/or the applicant/s have cited them on PTO-1449, they have not been considered.

Claim Objections

Claim 81 is objected to because of the following informalities: The preamble recites a process for producing a mixture" while the claims are drawn for process of using/coating the mixture. Appropriate correction is required.

Claims 93-94 objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The claims do not further limit the process of coating in claim-81.

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Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 64, 68-72, 77, 83 and 101 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 64 recite the limitation of "a is present ... 0-60 %, in each case Whereby the compounds b) or c) or b) and c) are only used with a content of particles a)" in Lines-22-23 is indefinite in that when the amount of a) is zero.

Claim 64 recite the limitation of "where, however, not onlyany mixtures of these; wherein" in lines 7-10, and it is not clear what are included by this limitation.

Claim 64 recite the limitation of "soft particles" in Line-24 and there is insufficient antecedent basis for this limitation.

Claim 68 recite the limitation of "said average particle size d50" in Line-1 and there is insufficient antecedent basis for this limitation.

Claims 69-70, 77, 83 recite the limitation of "very-soft or soft particles" in Line-24 and there is insufficient antecedent basis for this limitation.

Claims 71-72 recite the limitation of "metallic particles" in Line-2 and there is insufficient antecedent basis for this limitation.

The examiner construes the particles to be present in the claim-64 for the purposes of the examination.

Claim 101 recites the limitation of "the weight contents of the water-insoluble or sparingly soluble pigmentation a)" in Lines 1-2 and there is insufficient antecedent basis for this limitation.

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Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 64-72, 77, 79-100 and 102-103 are rejected under 35 U.S.C. 102(b) as anticipated by Wiechelhaus et al (WO 99/24545).

The US patent 6,479,103 issued to Wiechelhaus et al is being used as the English Translation of the WO Document.

Wiechelhaus et al teach the composition of a corrosion resistant coating composition comprising 10 to 40 wt. % of an organic binder; 0 to 15 wt.% of a silicate-based anti-corrosive pigment, 40 to 70 wt.% of powdered zinc, aluminum <hard particles>, graphite and/or molybdenum disulfide <soft particle>, iron phosphide <hard particle> or BaSO₄ doped with Sn or Sb, together with 0 to 30 wt.% of a solvent, wherein the organic binder consists of at least one epoxy, at least one curing agent selected from guanidine, substituted guanidines, substituted ureas, cyclic tertiary amines and mixtures thereof, together with at least one blocked polyurethane resin (Abstract; Cl-3, Ln 1-29; Cl-5, Ln 49-64; Tables 1-3; Cl-6, Ln 34). The wt % of the components meets the limitation component ratios in the claim-64. The composition further contained lubricants, soluble dyes and coloring pigments. The steel sheet metal was cleaned, optionally chromated <precoated> and then coated with 2-5 micron coating, whereby the particles present in the coating are necessarily less than 2 micron in diameter for a monolayer film over a surface with a 2-

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micron thick coating, that meets the limitation of particle sizes in the claims. With regard to claim-80, the prior art teaches adding 0.2% modified castor oil (Table-1). With regard to process claims, the prior art further teaches coating the composition over a metal surface and drying the coating at a peak metal temperature of 180-235C (CI-6, Ln 9-17). With regard to the process steps in claims 83-86, the examiner asserts that the prior art coating will be either same or substantially same as that produced by the claimed process steps. With regard to claim-100, the prior art teaches adding a mixture of polyurethane and MDI (CI-5, Ln 19-23). All the limitations of the instant claims are met.

The reference is anticipatory.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the

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examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

1. Claims 64 and 73-76 rejected under 35 U.S.C. 103(a) as being unpatentable over Soltwedel (US 6,008,462).

Soltwedel teaches a mar resistant corrosion inhibiting weldable coating for metals comprising organic binders, metallic and inorganic fillers such as oxides, crosslinker, solvent, catalysts such as tertiary amines, suspension agent, lubricants such as molybdenum disulfide or fatty acid salts and up to about 10 wt% corrosion inhibiting agents such as zinc with a particle size of 2-6 micron and solvents (Abstract, CI-4, Ln 22-41; CI-7, Ln 11-17; CI-8, Ln 25-30; CI-9, Ln 35-59; CI-10, Ln 38-40, Ln 60-67; CI13-14, Table-1). The weldable coating was about 0.4-0.6 mil (10-15 micron) (CI-13, Ln 9-15). The composition given in Example-1 meets the component ratio limitations in the claim-64.

The prior art is silent about the exact particle size distribution of Iron particles.

However, the prior teaches the iron particles to have a size less than -325 sieve (44 micron) that encompasses less than or equal to 6 micron particle size for conductive fillers, and In the case where the claimed ranges "overlap or lie inside ranges disclosed by the prior art" a prima facie case of obviousness exists. In re Wertheim, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); In re Woodruff, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990).

With regard to claims 73-74 and 76, the prior art teaches a composition containing 8.42 wt% titania (Example-1) that is close to claimed at least 10 wt%, and a prima facie case of obviousness exists where the claimed ranges and prior art ranges do not overlap but are close enough that one skilled in the art would have expected them to have the same properties. Titanium Metals Corp. of America v. Banner, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985) (Court held as proper a rejection of a claim directed to an alloy of "having 0.8% nickel, 0.3% molybdenum, up to 0.1% iron, balance titanium" as obvious over a reference disclosing alloys of 0.75% nickel, 0.25% molybdenum, balance titanium and 0.94% nickel, 0.31% molybdenum, balance titanium.).

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2. Claims 64-68, 71-72 and 78 rejected under 35 U.S.C. 103(a) as being unpatentable over Hawkins et al (5,976,419).

Hawkins et al teach a coating composition containing a resin binder such as polyurethane, lcp polymers such as polyaniline, metal particles such as Al (Al-130, particle size 1-2 micron, See Data Sheet), plasticizers curing agent and additives including solvent (Abstract, Cl-3, Ln 43-Cl-4, Ln 25). The typical compositions in Examples 1-3 give the ratio of the components in the coating composition wherein the binder ranged from 51-54 wt% for the examples. The prior art conductive filler ratios in vol% when calculated overlapped with instant claimed wt% ratios for conductive fillers.

The prior art fails to teach the instant claimed ratio of binders.

The prior art teaches exemplary compositions containing 51-54 vol% binders that is close to claimed ratio of 42 wt%, and a prima facie case of obviousness exists where the claimed ranges and prior art ranges do not overlap but are close enough that one skilled in the art would have expected them to have the same properties. *Titanium Metals Corp. of America v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985) (Court held as proper a rejection of a claim directed to an alloy of "having 0.8% nickel, 0.3% molybdenum, up to 0.1% iron, balance titanium" as obvious over a reference disclosing alloys of 0.75% nickel, 0.25% molybdenum, balance titanium and 0.94% nickel, 0.31% molybdenum, balance titanium.).

With regard to claims 65-68 and 71-72, the prior art teaches Al-130.

With regard to claim 78, the prior art teaches PANI.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 64-68, 76, 80, 99 and 101 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 31-35, 50, 56, 69-70 of copending Application No. 10/511242. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant application and copending application are drawn to similar compositions having similar components and same utility as conductive coatings, while the instant claims contain specific ranges of components and differ from the copending claims that do not have the ranges, and it would be obvious to a person of ordinary skill in the art to optimize the composition for coating applications because they are well known in the art (See Wiechelhaus et al (WO 99/24545).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

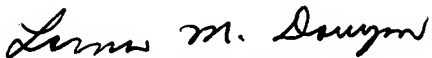
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kallambella Vijayakumar whose telephone number is 571-272-1324. The examiner can normally be reached on 8.30-6.00 Mon-Thu, 8.30-5.00 Alt Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Douglas McGinty can be reached on 571-272-1029. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KMV
June 25, 2007.


LORNA M. DOUYON
PRIMARY EXAMINER